



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/726,423

12/03/2003

Roy Schoenberg

66729/P032US/10614704

5827

29053 7590 02/04/2009
FULBRIGHT & JAWORSKI L.L.P
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201-2784

EXAMINER

RANGREJ, SHEETAL

ART UNIT

PAPER NUMBER

3686

MAIL DATE

DELIVERY MODE

02/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/726,423	Applicant(s) SCHOENBERG, ROY	
	Examiner SHEETAL R. RANGREJ	Art Unit 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/09/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History Summary

1. Claims 1-36 are pending.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 02/09/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "12", "14", and "16" all been used to designate "access keys"; reference characters "20", "22", and "24" all been used to designate "patients"; reference characters "60", "62", and "64" all been used to designate "medical records". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 12, and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. The basis of this rejection is based on recent Federal Circuit decisions and Supreme Court precedent in particular, *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876) which state that the process must:

(1) be tied to another statutory class (such as a particular apparatus); or

(2) transform underlying subject matter (such as an article or materials) to a different state or thing.

For a claimed invention to be statutory subject matter eligible, the claimed invention must fall within a judicial exception. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited claims should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that

accomplishes the method steps or positively recite subject matter that is being transformed for example by identifying the material that is being changed to a different state.

6. In the present case, claims 1, 12, and 19 recite an abstract idea only. The claims recite steps and means for a) defining processes, b) forming links between processes, traversing processes by meeting exit requirements. These steps and means do not apply, involve, use, or advance the technological arts since they can be performed in the mind of the user or by use of a pencil and paper. These steps and means only constitute an idea of how to define, linking and traversing processes.

7. The Examiner directs Applicant's attention to claim 28 as a possible way to amend the claims to put them within a judicial exception. In particular, explicitly claiming the medium or structure in the body of the claim that performs the underlying process steps would serve to better recite the technological arts within the present set of claims.

Claim Rejections - 35 USC § 112

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Soong (U.S. Patent No. 6,941,271).

10. As per claim 1, Soong teaches a key organization method comprising:

-receiving a first access key that grants a patient-defined level of access to a first set of medical records (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**);

-receiving a second access key that grants a patient-defined level of access to a second set of medical records (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**); and

-storing the first and second access keys in a centralized key repository (**Soong: col. 11, 6-50**).

11. As per claim 2, the method of claim 1 is as described. Soong further teaches wherein the first access key is generated by a first patient (**Soong: col. 6, 14 to col. 7, 20**), and the first set of medical records concern the first patient (**Soong: col. 7, 20-52**).

12. As per claim 3, the method of claim 1 is as described. Soong further teaches wherein the second access key is generated by a second patient (**Soong: col. 6, 14 to col. 7, 20**), and the second set of medical records concern the second patient (**Soong: col. 7, 20-52**). Changing the amount of keys generated and amounts of medical records concerning the patients does not change the invention as a whole, therefore the limitations are taught as mentioned.

13. As per claim 4, the method of claim 1 is as described. Soong further teaches further comprising accessing, through a client computer connected to a distributed computing network, the first set of medical records using the first access key (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**).

14. As per claim 5, the method of claim 4 is as described. Soong further teaches further comprising accessing, through the client computer connected to the distributed computing network, the second set of medical records using the second access key (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**). Changing the amount of keys generated and amounts of medical records concerning the patients does not change the invention as a whole, therefore the limitations are taught as mentioned.

15. As per claim 6, the method of claim 5 is as described. Soong further teaches wherein:
-the client computer is a personal computer (**Soong: figure 1**); and
-the distributed computing network is the Internet (**Soong: figure 1**).

16. As per claim 7, the method of claim 1 is as described. Soong further teaches further comprising storing the first and second medical records on a centralized medical record repository (**Soong: figure 1**).

17. As per claim 8, the method of claim 7 is as described. Soong further teaches wherein the centralized medical record repository and centralized key repository reside on and are executed by a remote server connected to a distributed computing network (**Soong: figure 1**).

18. As per claim 9, the method of claim 8 is as described. Soong further teaches wherein:
-the remote server is a web server (**Soong: col. 3, 60 to col. 4, 1**); and
-the distributed computing network is the Internet (**Soong: col. 3, 60 to col. 4, 1**).

19. As per claim 10, the method of claim 1 is as described. Soong further teaches wherein the first set of medical records is a multi-portion medical record and the first access key provides

access to one or more portions of the first set of medical records (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**).

20. As per claim 11, the method of claim 1 is as described. Soong further teaches wherein the second set of medical records is a multi-portion medical record and the second access key provides access to one or more portions of the second set of medical records (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**).

21. As per claim 2, Soong teaches a key distribution method comprising:

- transmitting, from a first patient, a first access key that grants a patient-defined level of access to a first set of medical records (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**);

- transmitting, from a second patient, a second access key that grants a patient-defined level of access to a second set of medical records (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**); and

- storing the first and second access keys in a centralized key repository (**Soong: col. 11, 6-50**).

22. As per claim 13, the method of claim 12 is as described. Soong further teaches further comprising accessing the first set of medical records using the first access key (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**).

23. As per claim 14, the method of claim 12 is as described. Soong further teaches further comprising accessing the second set of medical records using the second access key (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**).

24. As per claim 15, the method of claim 12 is as described. Soong further teaches further comprising storing the first and second medical records on a centralized medical record repository (**Soong: col. 11, 6-50**).

25. As per claim 16, the method of claim 15 is as described. Soong further teaches wherein the centralized medical record repository and centralized key repository reside on and are executed by a remote server connected to a distributed computing network (**Soong: figure 1**).

26. As per claim 17, the method of claim 12 is as described. Soong further teaches wherein the first set of medical records is a multi-portion medical record and the first access key provides access to one or more portions of the first set of medical records (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**).

27. As per claim 18, the method of claim 12 is as described. Soong further teaches wherein the second set of medical records is a multi-portion medical record and the second access key provides access to one or more portions of the second set of medical records (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**).

28. As per claim 19, Soong teaches a key organization method comprising:
-maintaining, on a remote server, a centralized key repository and a centralized medical record repository (**Soong: figure 1; col. 6, 14 to col. 7, 20**); and
-storing a first set of medical records and a second set of medical records on the centralized medical record repository (**Soong: figure 1; col. 6, 14 to col. 7, 20**).

29. As per claim 20, the method of claim 19 is as described. Soong further teaches further comprising:
-receiving, from a first patient, a first access key that grants a patient-defined level of access to the first set of medical record (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**); and

-receiving, from a second patient, a second access key that grants a patient-defined level of access to the second set of medical records (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**).

30. As per claim 21, the method of claim 20 is as described. Soong further teaches further comprising storing the first and second access keys in the centralized key repository (**Soong: figure 1**).

31. As per claim 22, the method of claim 19 is as described. Soong further teaches further comprising accessing the first set of medical records using the first access key (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**).

32. As per claim 23, the method of claim 19 is as described. Soong further teaches further comprising accessing the second set of medical records using the second access key (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**).

33. As per claim 24, the method of claim 19 is as described. Soong further teaches wherein the centralized medical record repository and centralized key repository reside on and are executed by a remote server connected to a distributed computing network (**Soong: figure 1**).

34. As per claim 25, the method of claim 24 is as described. Soong further teaches wherein:
-the remote server is a web server (**Soong: figure 1**); and
-the distributed computing network is the Internet (**Soong: figure 1**).

35. As per claim 26, the method of claim 19 is as described. Soong further teaches wherein the first set of medical records is a multi-portion medical record and the first access key provides access to one or more portions of the first set of medical records (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**).

36. As per claim 27, the method of claim 19 is as described. Soong further teaches wherein the second set of medical records is a multi-portion medical record and the second access key provides access to one or more portions of the second set of medical records (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**).

37. As per claim 28, Soong teaches a key organization system comprising:

- a server system including a computer processor and associated memory, the server system having a centralized key repository and a centralized medical record repository (**Soong: figure 1**);

- wherein the server system is configured to:

- store a first set of medical records and a second set of medical records on the centralized medical record repository (**Soong: col. 6, 14 to col. 7, 20**);

- receive a first access key that grants a patient-defined level of access to the first set of medical records (**Soong: col. 6, 14 to col. 7, 20**);

- receive a second access key that grants a patient-defined level of access to the second set of medical records (**Soong: col. 6, 14 to col. 7, 20**); and

- store the first access key and the second access key on the centralized key repository (**Soong: figure 1; col. 6, 14 to col. 7, 20**).

38. As per claim 29, the system of claim 28 is as described. Soong further teaches further comprising a client system including a computer processor and associated memory, the client system being configured to:

-access the first set of medical records using the first access key (**Soong: col. 6, 14 to col. 7, 20**);
and

-access the second set of medical records using the second access key (**Soong: col. 6, 14 to col. 7, 20**).

39. As per claim 30, the system of claim 29 is as described. Soong further teaches wherein the server system and the client system are coupled via a distributed computing network (**Soong: figure 1**).

40. As per claim 31, the system of claim 30 is as described. Soong further teaches wherein the distributed computing network is the Internet (**Soong: figure 1**).

41. As per claim 32, the system of claim 28 is as described. Soong further teaches wherein the first set of medical records is a multi-portion medical record and the first access key provides access to one or more portions of the first set of medical records (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**).

42. As per claim 33, the system of claim 28 is as described. Soong further teaches wherein the second set of medical records is a multi-portion medical record and the second access key provides access to one or more portions of the second set of medical records (**Soong: col. 6, 14 to col. 7, 20; col. 11, 6-50**).

43. As per claim **34**, it is an article of manufacture claim which repeats the same limitations of claim **1**, the corresponding method claim, as a collection of executable instructions stored on machine readable media as opposed to a series of process steps. Since the teachings of **Soong** disclose the underlying process steps that constitute the method of claim **1**, it is respectfully

submitted that they likewise disclose the executable instructions that perform the steps as well.

As such, the limitations of claim **34**, are rejected for the same reasons given above for claim **1**.

44. As per claim **35**, it is an article of manufacture claim which repeats the same limitations of claim **12**, the corresponding method claim, as a collection of executable instructions stored on machine readable media as opposed to a series of process steps. Since the teachings of **Soong** disclose the underlying process steps that constitute the method of claim **1**, it is respectfully submitted that they likewise disclose the executable instructions that perform the steps as well. As such, the limitations of claim **35**, are rejected for the same reasons given above for claim **12**.

45. As per claim **36**, it is an article of manufacture claim which repeats the same limitations of claim **19**, the corresponding method claim, as a collection of executable instructions stored on machine readable media as opposed to a series of process steps. Since the teachings of **Soong** disclose the underlying process steps that constitute the method of claim **1**, it is respectfully submitted that they likewise disclose the executable instructions that perform the steps as well. As such, the limitations of claim **36**, are rejected for the same reasons given above for claim **19**.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEETAL R. RANGREJ whose telephone number is (571) 270-1368. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/SRR/
Patent Examiner
Art Unit 3686
January 26, 2009

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686